REMARKS

In the Office Action mailed September 25, 2003, claims 4–6, 8 and 9 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,004,863 to *Jang* and claims 7 and 10 were rejected under 35 U.S.C. § 103(a) over *Jang* in view of U.S. Patent No. 5,969,425 to *Chen*. In addition, claims 4–10 were rejected under 35 U.S.C. § 101 over U.S. Patent No. 5,958,795 for statutory double patenting.

Claims 4–10 are pending in the application. Reconsideration and withdrawal of rejections is respectfully requested in view of the following remarks.

A. The Rejection of the Claims under § 102 and § 103

Claims 4–6, 8 and 9 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,004,863 to *Jang* and claims 7 and 10 were rejected under 35 U.S.C. § 103(a) over *Jang* in view of U.S. Patent No. 5,969,425 to *Chen*. These rejections are traversed on the ground that *Jang* does not qualify as prior art in the present application.

As noted in the previous Response, *Jang* was filed May 6, 1998, after the April 18, 1998 filing date of Taiwanese priority application (Taiwan App. No. 87105966). A certified copy of the Taiwanese priority application was filed in a parent U.S. application (U.S. Pat. App. Serial No. 09/075,618). An English translation of the Taiwanese priority application, and a statement that the translation is accurate are enclosed herewith.

The Examiner should now have all the requisite papers that show the Taiwanese priority application overcomes the effective date of *Jang*. Accordingly, withdrawal of the rejection of claims 4–6, 8 and 9 under § 102(e) over *Jang*, and claims 7 and 10 under § 103(a) over *Jang* in view of *Chen* is respectfully requested.

B. The Rejection of the Claims for Statutory Double Patenting

Claims 4–10 were rejected under 35 U.S.C. § 101 over U.S. Patent No. 5,958,795 for statutory double patenting. This rejection is traversed.

A valid rejection under statutory double patenting requires that "the claimed inventions are identical in scope." *In re Goodman*, 11 F.3d 1046, 1052 (Fed. Cir.

1993). The claims of the present invention lack explicit limitations found in the claims of the '795 patent, so the claimed inventions cannot be identical in scope.

The step of "removing the oxide layer on a central part of the large active region to expose the silicon nitride layer" in claim 5 of the '795 patent is not identical in scope to the step in claim 4 of the present application, which does not require the silicon nitride layer to be exposed on at least some part of the wafer.

Similarly, the step of "forming a partial reverse active mask on the oxide layer, so that the central part of the large active region is exposed" is not identical in scope to the step in claim 8 that does not require the central part of the large active region to be exposed. For example, if a reverse active mask is formed that only exposes part of the large active region that is neither in the central part nor the edge part, it could still literally infringe claim 8 of the present invention.

These examples demonstrate that the claims of the present invention are not identical in scope to the claims of the '795 patent. Accordingly, withdrawal of the rejection of the claims under § 101 for statutory double patenting over the '795 patent is respectfully requested.

C. Conclusion

In view of all of the above, claims 4–10 are believed to be allowable and the case in condition for allowance, which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

No fees are believed to be required with this Response, and should any be required, please charge Deposit Account 50-1123. Should any extension of time be required, please consider this a petition therefore and charge the required fee to Deposit Account 50-1123.

Respectfully submitted,

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Eugene J. Bernard, Reg. No. 42,320
Hogan & Hartson L.L.P.
1200 17th Street, Suite 1500
Denver, Colorado 80202
(303) 454-2457 (telephone)
(303) 899-7333 (facsimile)